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Filed : February 27, 2004

### REMARKS

In response to the Office Action that reopened prosecution following the filing of Appellant's appeal brief, Applicant submits the following remarks.

#### Applicant's Prior Arguments

As an initial matter, Applicant would like to express its dismay with the statement on page 8 of the Office Action that "Applicant's arguments with respect to claims 1-7, 15-17, 24-38 have been considered but are moot in view of the new ground(s) of rejection." This statement is completely disingenuous with respect to Claims 1-7, 24-30, 36 and 38. Applicant will address below the new grounds used to reject Claims 4-6, 15-17, 25, 31-35 and 37.

Claims 1-3, 32, 36 and 38 remain rejected as anticipated by Hoshino – this is the same ground that was appealed. Claim 4 ultimately depends from Claim 1, Claim 2 and Claim 3, each of which remains rejected under the same grounds as appealed. Claims 24-28 are rejected as anticipated by Strauch – the rejection previously was obviousness-based in view of the same reference and, therefore, the same arguments still apply. Claim 7 remains rejected as unpatentable over Hoshino in view of Borenstein – this is the same ground that was appealed. Claims 24 and 29 remain rejected as unpatentable over Stehling in view of Strauch – this is the same ground that was appealed. Claims 24 and 30 remain rejected as unpatentable over Borenstein in view of Patterson – this is the same ground that was appealed. There has been no response in the Office Action to the arguments set forth in the Appeal Brief.

Applicant has appealed each of these rejections in an effort to have the Board of Patent Appeals evaluate the merits of the Examiner's rejections. Applicant is attempting to advance prosecution and, through a series of applications, has been attempting to secure the scope of rights to which the Applicant believes it is entitled. Applicant is a business entity that has finite resources for pursuing patent protection – advancement of its patent matters is required rather than merely rehashing the same arguments in responses that must be filed after its appeals are dismissed by the Patent Office. To the extent that the Examiner would have been overturned, even if only with respect to the claims that are the subject of new rejections, Applicant believes that it is entitled to the Board of Patent Appeals considering its arguments with respect to all grounds of rejection but Applicant is not willing to proceed to appeal on an incomplete record resulting from the new grounds of rejection. Ultimately, the claims that have been rejected on

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the same grounds as before will be appealed if they continue to be rejected, once the record is complete with respect to the newly rejected claims.

If the Examiner contests the arguments set forth in the Appeal Brief, and repeated yet again in this response, the Examiner is requested to set forth the points specific of disagreement so those points can be identified in any later filed Appeal Brief. Applicant also requests some certainty in those points, unlike the prior construction of Hoshino that Applicant confirmed with the Examiner only to have a different view expressed in the present Office Action.

While Applicant had the option of addressing the new grounds of rejection on Appeal, as mentioned above, Applicant does not believe that addressing rejections of first impression is a good use of the already crowded docket of the Board of Patent Appeals and, therefore, is responding first through this response to the Office Action.

**Claim 33 Complies with 35 U.S.C. § 112, Second Paragraph**

Claim 33 has been rejected as not complying with 35 U.S.C. § 112, second paragraph. The Examiner stated that it is not clear whether the Applicant intends to claim the combination of the locking cap and the fire department connection or the locking cap alone.

As explained previously, Claim 33 recites a locking cap for a fire department connection. The limitations relating to the fire department connection are used to provide a context in which the locking cap of Claim 33 is used and to provide limitations relating to the environment. Indeed, the limitations are a specific attempt by Applicant to limit the locking cap of Claim 33 to locking caps that are sized for use with fire department connections. Moreover, by reciting limitations in the body of the claim relating to the fire department connection, Applicant intends for the preamble of Claim 33 to be limiting such that the claim is directed to “a locking cap for a fire department connection” and such that the claim is not construed to be any object that can be inserted into any opening and secured therein. See, for instance, Hoshino and Ball Sr.

One of skill in the art would clearly understand the claim as being infringed by a locking cap for a fire department connection wherein the locking cap has a plug portion that is sized and configured to be received by the pipe end of the fire department connection with the side surface of the plug portion having a surface area generally coextensive with an inner contacted surface of the pipe end of the fire department connection. Fire department connections are standardized components. There is no ambiguity in these limitations. In any event, one need not have both a

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fire department connection and the locking cap in order to infringe Claim 33; rather, the infringer need only manufacture, use, sell or import a locking cap having a plug portion sized and configured to be received by the pipe end of the fire department connection with a side surface of the plug portion having a surface area generally coextensive with an inner contacted surface of the pipe end of the fire department connection.

Because Claim 33 is clear in its current form, Applicant respectfully requests withdrawal of the rejection of Claim 33.

**Claim 28 Has Been Corrected**

While Applicant disagrees with the objection to Claim 28, Applicant has revised the language of Claim 28 and submits that the claim further defines the structure recited by Claim 24. Withdrawal of the objection is respectfully requested.

**Claims 1–4, 32, 36 and 38 Are Not Anticipated by Hoshino**

Claims 1–4, 32, 36 and 38 stand rejected as anticipated by Hoshino (U.S. Patent No. 5,419,650); however, Hoshino did not disclose each limitation of the rejected claims.

Claims 1 and 32 are independent claims with Claims 2, 3, 4, 36 and 38 depending from Claim 1. Each of independent Claims 1 and 32 recites, among other limitations, a slot extending longitudinally between a front surface of the plug portion and a rear surface of the plug portion and radially between a side surface of the plug portion and a relief opening defined within the plug portion.

The Examiner has modified the previous understanding of Hoshino relied upon by Applicant during prosecution of the present application and previous applications. Applicant explicitly asked for, and received in the Office Action mailed June 24, 2005, confirmation of Applicant's understanding of the Examiner's construction of Hoshino. The Examiner previously expressly confirmed that the "relief opening" of Hoshino was the region defined between the sloping surfaces 24, 25 and a cylindrical upward and downward extension of surface 23 while the cylindrical extension defined the channel. The Examiner now contends that the relief opening (which MUST be WITHIN the plug portion – the same plug portion identified as element 21 by the Examiner) is "the top plane of slot 22 corresponding to the thickness of the wall of plug member 21, i.e., the entrance of the open ended slot 22." The Examiner also now contends that

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the channel is defined by surfaces 23, 24 and 25, which previously defined the channel and the relief opening together.

The change in construction of Hoshino reflects the difficulty the Examiner has in arguing that the rejected claims are anticipated by Hoshino – even this second completely different construction of Hoshino does not disclose every limitation of Hoshino. Claim 1 recites, among other limitations:

the plug portion having a front surface, a rear surface and a side surface, a slot extending longitudinally between the front surface and the rear surface and radially between the side surface and a relief opening defined within the plug portion...

Emphasis added. In struggling to place the relief opening somewhere within the plug portion that would allow the channel to contact the spreader member, the Examiner has left out at least two limitations relating to the relief opening.

First, the relief opening must be defined within the plug portion. The Examiner has identified component 21 of Hoshino as corresponding to the plug portion. If, as contended by the Examiner, the relief opening is “the top plane of slot 22 corresponding to the thickness of the wall of the plug member 21,” then the relief opening is clearly outside of the plug portion since the slot 22 extends the full length of the plug portion 21 of Hoshino.

Second, the slot 22 must extend radially between the side surface and the relief opening. If the relief opening is the top plane of the slot, then the slot cannot be extending radially between the side surface and the relief opening because the relief opening and the side surface extend normal to each other.

For at least these reasons, Claim 1 clearly is not anticipated by Hoshino. Claim 32 recites similar limitations to those discussed directly above (e.g., relief opening within the plug portion and slot extending radially between). Claims 2-4, 36 and 38 all depend from Claim 1 and are not anticipated for at least the same reasons that Claim 1 is not anticipated. Applicant requests that the Examiner please withdraw the strained rejections over Hoshion – which is not a locking cap and it not configured for such a function.

#### **Claims 24-28 Are Not Anticipated by Strauch**

Claims 24-28 have been newly rejected as anticipated by Strauch. The Examiner previously rejected Claims 24-28 as unpatentable over Strauch. Thus, while the Examiner

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appears to be treating this rejection as a new grounds of rejection, the rejection truly is a rehash of ground previously covered. Applicant argued against the obviousness rejection – and the weakness of the rejection is exacerbated by changing the rejection to anticipation.

Strauch disclosed a torque-exerting tool such as a screwdriver in which the shank section of the tool had a lower torsion spring constant than the working portion – it did not disclose a **KEY** under any reasonable interpretation of the word key that is consistent with the present application. There is no disclosure in Strauch of a key for use with a locking cap.

Claims 24, 26 and 27

Claim 24 recites, among other limitations, a locking cap key for locking and unlocking a locking cap...the head selectively engageable with a related structure on the locking cap. Applicant submits that the preamble recitation of a locking cap key is a limitation on the claim and that a screwdriver bit is not a key. Moreover, the teaching by Strauch of a deforming screwdriver bit is not a disclosure of a deformable locking cap key that is engageable with a related structure on the locking cap. Clearly, without such a disclosure, Claim 24 is not anticipated by Strauch. Withdrawal of the rejection is respectfully requested.

Claims 26 and 27 depend from Claim 24 and are not anticipated for at least the same reasons that Claim 24 is not anticipated by the applied reference. Applicant respectfully requests withdrawal of the rejection of Claims 26 and 27.

Claim 25

Claim 25 depends from Claim 24 and is not anticipated by the applied reference for at least the same reasons that Claim 24 is not anticipated by the applied reference. Claim 25 also recites, among other limitations, that the handle be configured to plastically deform when a level of torque exceeds a predetermined level of torque required to lock the locking cap in position. Strauch does not disclose a handle – Strauch discloses a screwdriver bit that can be received in a separate handle or that can be received in a chuck of a drill or the like. Thus, there is no disclosure in Strauch of a handle that is configured to plastically deform when a level of torque exceeds a predetermined level of torque required to lock the locking cap in position. Without the requisite disclosure, Claim 25 is not anticipated by Strauch. Applicant respectfully requests withdrawal of the rejection of Claim 25.

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Claim 28

Claim 28 depends from Claim 24 and is not anticipated by the applied reference for at least the same reasons that Claim 24 is not anticipated by the applied reference. Claim 28 also recites, among other limitations, complementary structures on the cap and key. As explained above, there is no disclosure in Strauch of a locking cap or a key. Without such a disclosure, Claim 28 is not anticipated by the reference. Applicant respectfully requests withdrawal of the rejection of Claim 28.

**Claims 7 and 33 Are Patentable Over the Combination of Hoshino and Borenstein**

Claims 7 and 33 stand rejected as unpatentable over the combination of Hoshino and Borenstein (U.S. Patent No. 4,651,771). However, the Examiner has not established a *prima facie* case of obviousness.

The Patent and Trademark Office has the burden under 35 USC 103 to establish a *prima facie* case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-87 (Fed. Cir. 1984). To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See M.P.E.P. § 2143*. Here, Hoshino and Borenstein are not properly combinable.

The Office Action states that "Hoshino teaches a plug member on a locking cap but fails to specify the material used." Borenstein is then combined with Hoshino to assert that the material from Borenstein, brass, can be combined with Hoshino, and in doing so, the combination allegedly renders Claim 7 obvious. Applicant respectfully submits that Claim 7 is patentable over this combination and that the combination is improper.

First, Claim 7 depends from Claim 1, and as explained previously, Hoshino does not teach all the limitations recited in Claim 1. As Borenstein is only combined with Hoshino to establish a choice of material, the combination of Hoshino and Borenstein still lack a teaching or suggestion of all the limitations of Claim 1 for the reasons set forth above. Accordingly, Claim 7 should be allowed because it depends from an allowable claim.

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Second, if Hoshino and Borenstein are combined, the combination would be for the purpose of establishing a brass plug portion. The plug portion of Hoshino, however, is a thin-walled tube, and combining the references would necessarily result in a brass, thin-walled tube. The brass, thin-walled tube would necessarily yield too easily and would not return to a compressed state when the moveable member is retracted. Thus, the combination would render Hoshino unfit for its intended purposes. Applicant, therefore, respectfully submits that the combination of Hoshino and Borenstein is inappropriate as it would render the modified reference unfit for its intended purpose.

With respect to Claim 33, the Examiner has argued that it “would have been obvious to one of ordinary skill in the art to combine the teachings of Hoshino and Borenstein by providing a locking cap with the pipe cap expander arrangement taught by Hoshino on a fire department connection pipe taught by Borenstein as an obvious matter of design choice in substituting one type of pipe cap for another. First, Hoshino had nothing to do with fire department pipes (Hoshino taught an expandable member that was used to fasten signs to open ended pipes) while Borenstein acknowledged a need for providing a tamper proof hydrant arrangement. There is absolutely no teaching or suggestion in the prior art of making the substitution of a non-secure fastening structure for fastening a pipe to another element (e.g., a sign) in place of a secure hydrant cap. Moreover, prior to Applicant’s development of the expandable locking cap, there was no expander arrangement available as a design choice, which is evidenced by the Examiner’s continuing strained rejections based upon non-analogous prior art and prior art that has limited, if any, application in the field of securing fire department connections. Thus, there is no motivation to make the applied combination.

Moreover, as explained above, Hosino failed to disclose a number of limitations recited by Claim 33 that are in common with limitations recited by Claim 1 (e.g., relief opening within the plug portion and slot extending radially between). These limitations were not taught or suggested by either reference and, therefore, a *prima facie* case of obviousness has not be established for this reason as well.

For at least these reasons, Claims 7 and 33 are not rendered unpatentable by the combination of Hoshino and Borenstein. Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 7 and 33.

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**Claims 5 and 6 Are Patentable Over the Combination of Hoshino and Lanham**

Claims 5 and 6 have been rejected as unpatentable over Hoshino in view of Lanham. As explained previously, Hoshino does not teach all the limitations recited in Claim 1. As Lanham is only combined with Hoshino to establish a specific key head, the combination of Hoshino and Lanham still lack a teaching or suggestion of all the limitations of Claim 1 for the reasons discussed above with respect to Claim 1. Accordingly, Claims 5-6 are patentable over the applied combination. Withdrawal of the rejections of Claims 5 and 6 is respectfully requested.

**Claims 15-17 Have Been Cancelled**

Claims 15-17 have been rejected as unpatentable over Ball Sr. (U.S. Patent No. 6,017,177) in view of Young (U.S. Patent No. 5,863,166). While Applicant respectfully disagrees that the combination is properly applied against the locking caps recited by Claims 15-17, Applicant has cancelled Claims 15-17 while reserving the right to pursue claims at least as broad as the cancelled claims in a continuation application.

**Claims 24 and 29 Are Patentable Over Stehling and Strauch**

Claims 24 and 29 have been rejected as unpatentable over Stehling in view of Strauch. Applicant disagrees with the rejection. Stehling and Strauch are not properly combinable. Even if combined, Stehling and Strauch did not teach or suggest each limitation of the rejected claims.

Stehling taught a wrench that had multiple purposes: (1) removing a fire hydrant cap; (2) actuating a fire hydrant by manipulating the valve stem; (3) operating equipment on the truck. Accordingly, the same wrench was used for activities requiring varied levels of torque. There is no teaching or suggestion to configure the handle of the wrench to plastically deform when a level of torque exceeded a predetermined torque. Such a configuration would require that the level of torque be set to the greatest torque that the wrench needed to impart, regardless of whether that torque was in association with the cap, the valve stem or the equipment on the truck.

Strauch taught a torque-exerting tool such as a screwdriver in which the shank section of the tool had a lower torsion spring constant relative to the working portion. The shank was capable of plastic deformation following an elastic deformation. Strauch also did not provide any motivation to combine the two references.

The Examiner stated that "[i]t would have been obvious to one of ordinary skill in the art to modify the key of Stehling by providing a deformation zone as taught by Strauch et al as an



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obvious matter of design choice in enhancing the security of the lock cap.” This asserted suggestion of the combination’s desirability, however, does not come from either of the references or the prior art of record. In this regard, Stehling says nothing about the need for to protect the cap from being over-tightened. Indeed, Stehling anticipates that, once tightened, actions taken by vandals may cause further tightening of the cap. In addition, Strauch says nothing about using the deformation feature taught by Strauch in the environment of a locking cap – Strauch is only concerned with tool bits. Thus, nothing can be taken from either reference that would suggest incorporating Strauch’s deforming feature with the wrench disclosed by Stehling.

Moreover, as explained at Col. 1, lines 53-56, the torque applied to the wrench is considerable. The cap would be installed using the wrench. Col. 3, lines 7-11. Protecting the cap would require that the wrench deform when the torque applied during tightening exceeds the predetermined torque. However, if vandals attempt to remove the cap, the cap further tightens onto the fire hydrant. Thus, to remove the cap, the allowable torque would necessarily have to be greater than the torque at which the wrench deformed during installation of the cap. Thus, to protect the cap by limiting installation torque, the ability to always be able to remove the cap in an emergency would be compromised. For this additional reason, modifying the wrench of Stehling by providing a deformation zone as taught by Strauch would render the disclosed invention of Strauch unusable for its intended purpose and, therefore, such a modification would not be proper.

For at least these reasons, the combination of Stehling and Strauch is not proper and Claims 24 and 29 are properly patentable. Applicant respectfully requests withdrawal of the rejections of Claims 24 and 29.

**Claims 24 and 30 Are Patentable Over Borenstein and Patterson**

Claims 24 and 30 stand rejected as unpatentable over Borenstein in view of Patterson. The two references, however, do not teach or suggest each limitation of Claims 24 and 30.

Borenstein taught a wrench for use with a fire hydrant protective cap. Patterson taught a disposable torque wrench for dental components. The torque wrench of Patterson requires a relief cut to ensure that the wrench will yield as described by the patent.

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Claim 24 recites, among other limitations, that the locking cap keys do not include a relief cut, as required by Patterson. Accordingly, Applicant respectfully submits that neither reference taught or suggested a handle that was configured to plastically deform when a level of torque exceeded a predetermined level of torque and where the key did not require a relief cut. Without such a teaching, Claim 24 is properly patentable over the applied combination. Applicant respectfully requests withdrawal of the rejections of Claims 24 and 29.

**Acknowledgement of Allowability of Claims 31, 34, 35 and 37**

Applicant acknowledges with appreciation the allowance of Claim 31 and the indication that Claims 34, 35 and 37 recite patentable subject matter.

**CONCLUSION**

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve such issue promptly. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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